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10/663,387	09/16/2003	Daniel Easo	2003P11407 US	2914

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EXAMINER

PEACHES, RANDY

ART UNIT

PAPER NUMBER

2617

DATE MAILED: 04/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/663,387

Applicant(s)

EASO ET AL.

Examiner

Randy Peaches

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 19-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 19-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

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### DETAILED ACTION

The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 2617.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

***Claims 3-4, 6, 12-14, 19-21 and 26*** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Although the Applicant vaguely discloses in the Specification on page 5 lines 5-9 where a fake call control connection is originated in parallel to the said MT-LR request, no representation is indicated in the referenced figures; thus, hampering one of ordinary skill in the art to clearly interpret the Applicant's claimed language. rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. ***Claims 1-2, 5, 7-10 and 15*** are rejected under 35 U.S.C. 102(e) as being anticipated by Ignatius et al. (U.S. Patent Publication Number 2005/0043041 A1).

Regarding ***claim 1***, Ignatius et al. discloses communications network comprising:

- a plurality of Mobile Subscriber (MS) units. See paragraph {0042};
- at least one base transceiver station (BTS), each BTS communicating wirelessly with ones of said MS units in a network cell. See paragraph {0041};
- at least one mobile switching center (MSC) administering to said at least one BTS and to any neighboring ones of said at least one MSC. See paragraph {0044}; and
- at least one Gateway Mobile Location Center (GMLC) supporting location services (LCS) and providing an access node for LCS service requests, wherein requests for services from one MS unit of said plurality of MS units are not placed on hold until a LCS request to said one MS unit

completes. The Examiner interprets the above language where the functionality of the said LCS simultaneously processes the location request and other functions. Ignatius et al. discloses such occurrence in paragraph {0052}.

Regarding **claim 2**, according to **claim 1**, Ignatius et al. continues to disclose wherein a response to said request for services is provided to one MS unit before a response is provided for said LCS request. Ignatius et al. inherently provides support of the above language; in that, prior to the user initiating a request, a response regarding the presence of the said user in the area of the receiving base station is received by the said user equipment (MS). See paragraphs {0042 and 0044}.

Regarding **claim 5**, according to **claim 1**, Ignatius et al. continues to disclose:

- a Serving Mobile Location Center (SMLC) performing positional measurement for said plurality of MS units. See paragraph {0047}, wherein Ignatius et al. details in the given paragraph that the different (which includes SMLC) means of processing information for the position.

Regarding **claims 7 and 15**, according to **claims 1 and 10**, Ignatius et al. continues to disclose wherein said at least one cell is a plurality of cells, and said LCS service requests comprise requests for value added services, emergency services and legal and lawful interception services. See paragraph {0061}.

Regarding **claim 8**, according to **claim 1**, Ignatius et al. continues to disclose wherein said LCS service requests are mobile terminating location request (MT-LR) and said requests for services are mobile originated (MO) requests, wherein Ignatius et al. details in paragraph {0007} that a user equipment sends a request for location.

Regarding **claim 9**, according to **claim 1**, Ignatius et al. continues to disclose wherein said wireless communications network is a Global System for Mobile Communication (GSM) network. See paragraph {0040}.

Regarding **claim 10**, Ignatius et al. discloses a wireless communications network comprising:

- a plurality of Mobile Subscriber (MS) units. See paragraph {0042}.
- a plurality of base transceiver stations (BTSSs), each BTS in a network cell communicating wirelessly with ones of said MS units in said cell. See paragraph {0041};
- a plurality of base station controllers (BSCs) administering to ones of said plurality of BTSSs;
- a plurality of mobile switching centers (MSC) administering to said plurality of BSCs and to any neighboring ones of said plurality of MSCs;
- at least one Gateway Mobile Location Center (GMLC) supporting location services (LCS) and providing an access node for LCS service requests,

wherein requests for services from one MS unit of said plurality of MS units are not placed on hold until a LCS request to said one MS unit completes. The Examiner interprets the above language where the functionality of the said LCS simultaneously processes the location request and other functions. Ignatius et al. discloses such occurrence in paragraph {0052}.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. ***Claims 16-17 and 23-25*** are rejected under 35 U.S.C. 102(b) as being anticipated by *“Digital Cellular Telecommunications Systems (GSM); Universal Mobile Telecommunications System (UMTS); Functional Stage 2 Description of Location Services”*, hereinafter referenced as *“3GPP”*.

Regarding ***claim 16***, 3GPP discloses a method of managing a wireless communications network, said method comprising the steps of:

- initiating a mobile terminating location request (MT-LR) for a particular mobile subscriber (MS) unit. See section 9.1.1 and FIGURE 9.1;

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- idling the mobility management (MM) layer of said particular MS unit. See Section 8.3.1.1;
- initiating a mobile originated (MO) request for services from said particular MS unit. See section 9.2.1.1 and FIGURE 9.7;
- processing said MO request. See section 9.2.1.1; and
- providing a response to said MT-LR. See FIGURE 9.7.

Regarding **claim 17**, according to **claim 16**, the 3GPP continues to disclose wherein said response is provided in step (e) to said MT-LR after a response is provided to said MO request. See FIGURE 9.1.2.

Regarding **claim 23**, according to **claim 16**, the 3GPP continues to disclose wherein a wherein said MT-LR is a request for location service (LCS). See section 9.1.2.

Regarding **claim 24**, according to **claim 16**, the 3GPP continues to disclose said request for LCS provides tracking data for a mobile subscriber. See section 9.1.2.

Regarding **claim 25**, according to **claim 16**, the 3GPP continues to disclose wherein said wireless communications network is a Global System for Mobile Communication (GSM) network. See page 14, 1<sup>st</sup> paragraph.



***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. ***Claim 11*** is rejected under 35 U.S.C. 103(a) as being unpatentable over Ignatius et al. (U.S. Patent Publication Number 2005/0043041 A1) in view of *"Digital Cellular Telecommunications Systems (GSM); Universal Mobile Telecommunications System (UMTS); Functional Stage 2 Description of Location Services."*, hereinafter referenced as *"3GPP"*.

Regarding ***claim 11***, according to ***claim 10***, Ignatius et al. discloses a wireless communications network comprising:

- a plurality of Mobile Subscriber (MS) units. See paragraph {0042}.
- a plurality of base transceiver stations (BTSs), each BTS in a network cell communicating wirelessly with ones of said MS units in said cell. See paragraph {0041};
- a plurality of base station controllers (BSCs) administering to ones of said plurality of BTSs;

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- a plurality of mobile switching centers (MSC) administering to said plurality of BSCs and to any neighboring ones of said plurality of MSCs;
- at least one Gateway Mobile Location Center (GMLC) supporting location services (LCS) and providing an access node for LCS service requests, wherein requests for services from one MS unit of said plurality of MS units are not placed on hold until a LCS request to said one MS unit completes. The Examiner interprets the above language where the functionality of the said LCS simultaneously processes the location request and other functions. Ignatius et al. discloses such occurrence in paragraph {0052}.
- wherein said wireless communications network is a Global System for Mobile Communication (GSM) network. See paragraph {0040}.

However, Ignatius et al. fails to clearly disclose wherein responses to said MO requests are provided before a response is provided for a corresponding said MT-LR.

The "3GPP", details in figure 9.1.2 the process in which the said MO requests are provided before a response is provided for a corresponding said MT-LR.

Therefore, at the time of the invention it would have been obvious to a person of ordinary skilled in the art to modify the teaching of Ignatius et al. to include the teachings of the 3GPP in order to provide a system capable of simultaneously processing the location request from the network and the service request of the

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originating mobile station.

### ***Response to Arguments***

Applicant's arguments filed 10/21/2005 have been fully considered but they are not persuasive.

Regarding **claims 3, 4, 6, 12-14 and 18-21** the Applicant traverses the 35 U.S.C. §112 2<sup>nd</sup> paragraph as being indefinite for failing to particularly point out the claimed subject matter. The Examiner maintains that the claimed invention "faked call control" is not supported by the Specification or Drawings. Although stated vaguely on page 5 lines 5-9 of the Applicant's Specification, the information fails to render sufficient support to rely proper understanding to one of ordinary skill in the art. Further, although stated by the Applicant that the information is rendered in the Drawings, nowhere in any of the drawings does the phraseology appear. Therefore, the Examiner again maintains his position in the rejection of the said claims.

Regarding **claim 2**, the Applicant asserts that the claim calls for originating a request for services simultaneous to a LCS request. However, the Examiner interprets the claim as stated, "wherein a response to said request for services is provided to said one MS unit **"before"** a response is provided for said LCS request. Nowhere in the claim does it state that the actions are simultaneous; therefore, the Examiner maintains respectfully, that Ignaitus et al. clearly teaches of the claimed language as stated in the above Office Action.

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Regarding **claims 16-17 and 23-25**, the Examiner maintains that the cited prior art clearly renders sufficient support of the claimed language and therefore the rejection stands.

### **Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randy Peaches whose telephone number is (571) 272-7914. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Randy Peaches  
March 24, 2006



JOSEPH FEILD  
SUPERVISORY PATENT EXAMINER